IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No.: 3428
Michael Frederick KENRICH	Art Unit: 2493
Application No.: 10/690,243	Examiner: Farid HOMAYOUNMEHR
Filed: October 20, 2003	Atty. Docket: 2222.5460000
For: **Method and System for Proxy Approval of Security Changes for a File Security System**	

Reply Brief Under 37 C.F.R. § 41.41

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Sir:

Appellant filed a Brief on Appeal to the Board of Patent Appeals and Interferences for the above-captioned application on October 5, 2011, appealing the decision of the Examiner in the Final Office Action mailed August 1, 2011. The Examiner's Answer was mailed November 25, 2011. In reply to the Examiner's Answer, Appellant submits this Reply Brief under 37 C.F.R. § 41.41.

A. Morinville fails to obviate "determining, for at least one response received from the approvers, whether it remains possible for a quorum of the approvers to approve the requested security change"

Appellant maintains the position that U.S. Patent Application Publication No. 2002/0062240 to Morinville *et al.* ("Morinville"), in combination with U.S. Patent No. 6,754,665 to Futagami *et al.* ("Futagami") and U.S. Patent Application Publication No. 2002/0156726 to Kleckner *et al.*, do not teach or render obvious "determining, for at least

one response received from the approvers, ***whether it remains possible for a quorum of the approvers to approve the requested security change***," as recited in independent claim 1 and as recited in independent claims 15, 30, 34-36 and 49-51 using analogous language. (Emphasis Supplied)

As discussed in Appellant's Brief on Appeal, Morinville is directed automating business processes and to an approval process for such a business process which "is complete when either ***all*** of the approvers have approved the request, or one of the necessary approvers has declined the request." (Emphasis Supplied). For example, a company may wish to purchase computers. All approvers would have to approve the purchase for it to be approved. (Morinville, [0002], [0073] and [0089]).

The Examiner continues to misunderstand the crux of Appellant's argument. The Examiner's interpretation of Morinville is incorrect and its teachings are being twisted using impermissible hindsight. In fact, as argued in the Brief, Morinville in combination with Futagami and Kleckner, do not obviate "determining, for at least one response received from the approvers, ***whether it remains possible for a quorum of the approvers to approve the requested security change***."

First, Morinville entirely fails to refer to "a quorum of the approvers" because it would not matter if a quorum of approvers approved purchase of the computers. All approvers would have to approve.

Second, because it is NEVER possible for only a quorum of the managers in Morinville to approve a request, it would not be obvious to determine whether it remains possible for such an approval. There simply would be no reason to make such a

determination according to the teachings of Morinville. Unanimous approval by the managers is required in order for the approval process to succeed. If a single manager declines a request, it fails. Thus, one of ordinary skill in the art at the time of the invention would not have found the features of claim 1 obvious and not have been motivated to combine the teachings of Morinville with Futagami and Kleckner. Moreover, Morinville may not be modified so that a quorum of approvers could approve a request, because this would result in Morinville becoming entirely unsatisfactory for its intended purpose, i.e. that all managers approve a request for it to be approved. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The Examiner's acknowledgement on page 16 of the Answer that "Morinville requires 100% of the vote to approve a request" most aptly indicates why the Examiner's rejection should be reversed. As acknowledged, it is NEVER possible for only a quorum of the approvers to approve a request. Thus, it does not make sense that "determining, for at least one response received from the approvers, ***whether it remains possible for a quorum of the approvers to approve the requested security change"*** would be obvious in view of the teachings of Morinville. Morinville simply cannot cure the deficiencies of Futagami and Kleckner.

B. The Examiner has failed to comply with the "broadest reasonable interpretation" standard

To make the rejection of the claims, the Examiner has contorted the meaning of the term "quorum" in such a way that fails to comply with the "broadest reasonable interpretation consistent with the specification" standard which is to be followed by the

Office. *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). In the Examiner's Answer on pages 14-15, the Examiner states "[f]irst, appellant argues that Morinville does not teach a quorum. In response, Examiner refers to appellant's own citations of Morinville (paragraphs [0067-0068]) as reflected in their Appeal Brief pages 20-22. In that citation, appellant describes Morinville's approval process as involving ***identifying the right participants in a business process*** (e.g. a request). Said participants would approve the process. ***Therefore, Morinville clearly teaches a quorum of approvers***...The group of selected managers equates to appellant's quorum." (Emphasis Supplied). This interpretation is not consistent with the specification and is not consistent with the generally accepted meaning of the term "quorum."

Appellant's specification defines the meaning of "quorum" as recited in the claims in paragraphs [0044] and [0049]. Paragraph [0044] of the specification provides that "not all of the approvers within a set need to unanimously agree as to the approval decision; instead only a quorum of the members of an approver set need to agree." Paragraph [0049] of the specification provides an example which was cited in footnote of the Brief on page 22: "if an approver set has five approvers and requires a quorum of three, then if responses from three approvers have already denied approval, then approval by a quorum of approvers is no longer possible." In other words, according to the generally accepted meaning of "quorum," a "quorum" of the approvers is a ***majority of the approvers***. Applying similar logic, because it is never possible for only a majority of approvers to approve a request in Morinville, it would not be obvious to determine if it remains possible for such a majority of approvers to approve a request. All must approve and a mere majority is not enough in Morinville.

There would not be a motivation to make such a determination according to the teachings of Morinville.

C. The Examiner has introduced misconceptions into the Answer

Page 15 of the Examiner's Answer cites to paragraph [0024] of Appellant's specification and argues that this paragraph "agrees with use of hierarchical arrangements." However, "limitations appearing in the specification but not recited in the claim[s] should not be read into the claim[s]." See M.P.E.P. § 2111 and *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003).

Page 15 of the Examiner's Answer also questions the meaning of "a quorum of approvers" which was defined above and clearly defined on page 22 of the Brief as "more than 50% of the approvers." The Examiner notes "Examiner is not sure whether Appellant meant to say that [1] the quorum has to include more tha[n] (sic) 50% of the possible approvers, or [2] that more than 50% of the members of quorum are needed to approve a request." As provided above, according to the generally accepted meaning of the term "quorum" and as described in the specification, a "quorum" of the approvers is a majority of the approvers.

Regarding the "focal point of Examiner's argument" on page 16 of the Answer, the Examiner states that "nothing in said claimed feature distinguishes it from a scenario where the approval process fails when one of the members of the quorum disapproves the request. Said scenario is depicted by Morinville." As thoroughly explained in the Brief and this document, Morinville does not teach a "quorum" and simply teaches that if one approver disapproves a request, it fails. There is no reason to determine if a "quorum" approves

because it does not matter in Morinville and Morinville entirely fails to refer to "when one of the members of the quorum disapproves the request." The Examiner has continued to improperly read this into Morinville.

D. The Office failed to meet its burden regarding the rejection of dependent claim 29 and has now introduced a new improper rejection

Regarding the rejection of dependent claim 29, this rejection was brought to the attention of the Board as an example of one of the deficient rejections of the dependent claims. Both Office Action 4 and Final Office Action 4 each reject claim 29 and provide the following vague and incomplete justification: "a key store connected to the system that uses digital signatures is inherent to systems using digital signature because keys are integral parts of digital signatures.[1]" Nothing else is provided.

On page 26 of the Brief, Appellant noted that "[t]he Examiner has failed to refer to any of the applied references, thus, this appears to be a rejection based on Official Notice." The Examiner failed to cite to any portion of any of the cited references and also failed to allege that the rejection was based on "Official Notice." Appellant questioned the rejection because "Official Notice" is not "inherent" in a reference.

The Examiner's Answer has alleged that the rejection was based on "Official Notice." In fact, the Examiner used the term for the first time in the Examiner's Answer on page 18. Appellant submits that this amounts to a new rejection introduced in the Examiner's Answer. However, the new ground of rejection was not prominently identified

1 The terms "Office Action 4" and "Final Office Action 4" were defined in the Brief on Appeal.

and was not approved by a Technology Center Director. The rejection of claim 29 on page 12 of the Examiner's Answer is the identical deficient rejection provided in both Office Action 4 and Final Office Action 4. Thus, it is improper. Appellant requests that the appeal be maintained. (See M.P.E.P. § 1207.03).

If "Official Notice" was indeed taken by the Examiner in Office Action 4, it should have been noted by the Examiner in Final Office Action 4 that what was asserted by the Examiner was taken to be admitted prior art. That did not occur and the Examiner is now newly or retroactively attempting to take "Official Notice" when informed of the deficiency. See M.P.E.P. § 2144: "[i]f applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate."

Notably, M.P.E.P. § 2144 also provides that "***[t]he applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice*** so as to adequately traverse the rejection in the next reply after the Office action in which the common knowledge statement was made." (Emphasis Supplied).

Appellant asserts that the rejection in and of itself is questionable because it failed to explicitly state that the rejection was based on "Official Notice." Appellant submits that the Examiner failed to invoke "Official Notice" because there is nothing in the rejection in Final Office 4 or Office Action 4 that explicitly informs Appellant that the features were allegedly

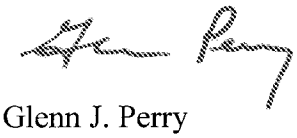
"well-known" or "common knowledge" and the Examiner failed to use the term "official notice." The Appellant cannot be faulted for failing to traverse a rejection which the Examiner is only now alleging is based on "Official Notice." The burden is on the Office to explicitly provide the basis for taking Official Notice, that burden was never met, and the burden to traverse a retroactive basis for a rejection should not be shifted to the Appellant. M.P.E.P. § 2144.03(B). Furthermore, as best understood, Appellant did traverse the improper rejection on page 26 of the Brief: "[A]ppellant submits 'a key store' as recited in claim 29 that is connected to the access server, as shown in Figure 2 of the specification would not merely have been common knowledge."

In fact, there is a failure to make a *prima facie* case of obviousness regarding claim 29. The Examiner has failed to provide any motivation or rationale to combine this alleged "Official Notice" with any of the cited references.

In light of the arguments above, as well as those set forth in Appellant's Brief on Appeal filed October 5, 2011. Appellant respectfully submits that the rejection of claims 1-16, 18-38 and 45-51 is improper and should be reversed.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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